

REMARKS

Applicants have amended Claims 1, 4, 9, 12, 14, and 16. Applicants have cancelled Claims 3 and 11. Claims 2, 5-8, 10, 13, and 15 are original claims. Claim 1 has been amended to incorporate the features of Claim 3. Claim 4 has been rewritten into independent form. Claim 9 has been amended to include all features of Claim 11. Claims 12, 15, and 16 have been amended and depend from Claim 9.

Drawings

The Examiner has required new drawings in this application because the “drawings filed on January 2, 2004 are informal.” Although it was once the policy of the Patent Office to consider drawings to be formal or informal, the Patent Office no longer makes this distinction. Drawings are either acceptable or not acceptable. M.P.E.P. 600-115. The Form Paragraph used by the Examiner 6.21 is used to notify the applicant of a defect in the drawings such as a missing reference numeral. 600-116. Considering the Examiner did not present any evidence of any defects in the drawings, it appears that the Examiner may have been relying on the old rule about informal drawings in making this objection. The current drawings are readable and reproducible and meet the requirements of M.P.E.P. 507, and therefore this objection should be withdrawn.

Claim Rejections

Claims 1 and 2

The Examiner rejected Claims 1-3 under 35 U.S.C. 102(e) as being anticipated by Holland (6,493,742). Claim 1 has been amended to include the additional steps previously set forth in Claim 3. More specifically, Claim 1 includes the step of “storing a set of compliance rules in the registry database, and comparing each of said notifications with said compliance rules prior to entry in the registry.” (See pages 11-12 of Applicant’s Specification.” Although the Examiner rejected Claim 3, he did not specify what portion(s) of Holland describe the storing and comparing step. Applicant asserts that Claim 1 is not anticipated by Holland.

Applicants have not been able to find any description in Holland of a process that includes the step of storing a set of compliance rules in a registry database as claimed in Claim 1. Further, Applicants have not been able to find description in Holland of a process that includes

the step of comparing notifications with compliance rules prior to entry in the registry. Accordingly, it appears that Holland does not anticipate Claim 1 as now presented. Therefore, the Examiner should withdraw the rejection of Claim 1. Claim 2 is dependent on Claim 1 and is patentable for at least the same reasons Claim 1 is patentable. If the Examiner intends to maintain the lack of novelty rejection of Claim 1 based on Holland in the next official action, then it is respectfully requested that he point out the portion or portions of the Holland patent which describe or suggest a process having all of the steps set forth in Claim 1.

Claims 4 and 5

Applicant has rewritten Claim 4 into independent form pursuant to the Examiner's indication that Claim 4 would be allowable if rewritten into independent form. Accordingly, Claim 4 is believed to be allowable. Claim 5 is dependent on Claim 4 and is allowable for at least the same reasons as Claim 4.

Claims 6-8

The Examiner rejected Claims 6-8 and 10 under 35 U.S.C. 103(a) as being unpatentable over Holland (6,493,742) in view of Thackston (6,295,513). As discussed above relative to Claim 1, Holland does not appear to disclose the steps of storing a set of compliance rules in the registry database, and comparing notifications with the compliance rules prior to entry in the registry. The combination proposed by the Examiner (Holland in view of Thackston) does not remedy the deficient disclosure of Holland. Claim 6 depends from Claim 1 and the Examiner's proposed combination does not disclose all the steps and features of Claim 6.

As the Examiner acknowledged, Holland does not describe receiving item records in XML format. The Examiner has contended that Thackston discloses that some web browsers are capable of reading or interpreting XML documents. The Applicant does not contest this statement. However, the fact that browsers can read XML documents would not lead one to modify the searching criteria of Holland to include XML. Thackston provides no motivation to use XML as opposed to any other internet protocol, and provides nothing more than the simple statement that browsers read XML. Thackston has not described any utility or advantage to using XML in a commercial data registry system or any other system. Therefore, the Examiner

has failed to establish the suggestion or motivation to combine the references and has not met the burden to establish a *prima facie* case of obvious as required in MPEP 2143.

Further, Thackston and Holland are non-analogous art. “In order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” *In re Oetiker*, 977 F.2d 1443. “A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.”

Holland discloses an “online special occasion” wedding registry system. Thackston discloses, “[A] comprehensive, integrated computer-based system and method for undertaking an engineering design and development effort in a virtual collaborative environment, identifying qualified fabricators for manufacturing a part design based on fabricator capability information stored in a global registry database substantially maintained by the fabricators themselves, and conducting a virtual bidding process whereby electronic representations of three dimensional model and specification data are provided by a central server. The central server further supports the bidding process by providing quasi-real time audio, video and graphics, and the contracts negotiation and formalization steps.” The system described in Thackston is designed to provide a solution to completely different problem in a different field of invention from Holland. Providing an improved online wedding registry is completely different than a virtual online contract bidding system. Further these references are classified in different classes, Holland 709/200 and Thackston 703/1. “...Patent Office classification of references and the cross-references in the official search notes of the class definitions are some evidence of ‘nonanalogy’...” *In re Ellis*, 476 F.2d 1370.

Regarding Claim 7, the Examiner has not explained what features of Thackston would be necessary to establish a case for obvious under 35 USC 103(a). Claim 7, which depends from Claim 6, requires the step of checking received item records for compliance with a predetermined document type definition. Holland alone or in combination with Thackston fails to describe the step of checking a received item record for compliance with a predetermined document type definition, as claimed. Applicant cannot find any steps in Holland or Thackston

that would be an equivalent of this step, and asserts that the Examiner has not made a *prima facie* case of obvious for Claim 7.

Regarding Claim 8, the Examiner has not explained what features of Thackston would be necessary to establish a case for obvious under 35 USC 103(a). Therefore, it is not clear why Holland alone or in combination with Thackston describes the method of Claim 8 comprising the step of transmitting notifications in the form of at least one of: (i) a worklist delivered to the local processing adapter via a graphical user interface to the registry, (ii) an email message, and (iii) an XML document transmission, on a user-selectable basis. Applicant cannot find any steps in Holland or Thackston that would be an equivalent of this step. Because of the absence of an appropriate explanation by the Examiner a *prima facie* case of obvious for Claim 8 has not been made.

Claims 9, 10, and 12-16

Applicant has incorporated the features of Claim 11 into independent Claim 9 pursuant to the Examiner's indication that Claim 11 would be allowable if rewritten into independent form. Therefore, Claim 9 as now presented is allowable. Claims 10 and 12-16 are dependent on Claim 9 and are allowable for at least the same reasons as Claim 9.

CONCLUSION

In view of the foregoing amendments and remarks, it is believed that the claims in this application are in condition for allowance. Early and favorable reconsideration is respectfully requested.

Respectfully submitted,
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